REMARKS

Claims Elected for Examination

The Examiner indicates in the Office Action that claims 1-11 have been elected for examination, as noted in paper #5. However, Applicant has no record of any restriction requirement being received, and has no record of submitting any election. In fact, Applicant has *not* submitted any election. Applicant has also examined the File Contents History of the present patent application within the USPTO's PAIR web site, and can find no indication of a restriction requirement being sent by the USPTO, or of Applicant submitting an election. Paper #5 is listed in the USPTO's PAIR web site as "Application Is Now Complete," when the application was still at the Office of Initial Patent Examination (OIPE), and thus is not either a restriction requirement or an election.

Therefore, Applicant strongly traverses the wholly improper election of the claims made *sua sponte* by the Examiner, without prior notice to Applicant, and without providing opportunity to Applicant to traverse a restriction requirement or make an election prior to substantive examination of the claims. In this regard, the current Office Action is wholly improper for being issued without such previous restriction requirement or election. Applicant responds to the arguments set forth within the Office Action to move along prosecution of the current application, and requests that the Examiner likewise promptly respond to this response. **However, Applicant also requests that a proper restriction requirement be proffered.**

References not Considered

The references "IBM PC Pro Camera" and "VideoMail Studio" were not considered as prior art due to the lack of a date of publication. The reference "IBM PC Pro Camera" should be dated as the year 2000, and the reference "VideoMail Studio" should be dated as copyright 1998.

Applicant therefore requests that these references be considered, and that in the next office action, a copy of the Form 1449 previously submitted be initialed as to these references.

Other References

Applicant has also submitted in a co-filed Information Disclosure Statement (IDS) the prior art that was found by the USPTO in the examination of a co-pending, related, patent application, having the first named inventor Curry, entitled "Email messaging program with built-in video and/or audio media recording and/or playback capabilities," filed on March 10, 2002, and assigned serial number 09/683,995 [attorney docket no. 1049.002US1]. Applicant requests the consideration of this additional prior art.

Claim Rejections Under 35 USC 102

Claims 1-11 have been rejected under 35 USC 102(b) as being anticipated by Ouhyoung ("The MOS Multimedia E-mail System," IEEE, 1994, pp. 315-324). Claim 1 is an independent claim, from which claims 2-11 ultimately depend. Applicant has amended claim 1. Applicant asserts that claim 1, as amended, is not anticipated by Ouhyoung. For at least the same reasons that claim 1 is patentable over Ouhyoung, therefore, claims 2-11 are also patentable. However, Applicant also provides reasons that claims 3-4 and 7 are not anticipated by Ouhyoung, such that these claims are patentable over Ouhyoung irrespective of the patentability of claim 1.

Claim 1

Claim 1 has been amended "such that the application program is unaware that the audio or video program has been integrated therewith." Support for this additional limitation, and guidance for interpreting it, is provided in the patent application as filed at least in paragraphs [0023] and [0024]. These paragraphs read in part:

> In one specific embodiment, the application program 104 is unaware that the audio or video program 106 has been integrated therewith. *This generally and in a non-limited manner means that the application program 104 has not been developed a priori with integration of the audio or video program 106 in mind, and also does not operate with knowledge that the audio or video program 106 has been integrated therewith.* Thus, the program 104 is not itself specially modified to allow integration of specifically the audio or video program 106.
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> . . . .
>
> In another specific embodiment, the application program 104 is specifically unaware that the audio or video program 106 has been integrated therewith. This means that the application program 104 may be generally aware that the audio or video program 106 has been integrated therewith. That is, some application programs may have extension mechanisms, via plug-ins or other types of add-in programs, that allow for extensibility of the application programs. As such, the application programs may be generally aware that other programs may be added thereon. However, the application program 14 is still specifically unaware that the audio or video program 106 has been integrated therewith.

(Emphasis added) Therefore, that claim 1 has been amended so that the application program is "unaware" that the audio or video program has been integrated therewith may be interpreted in light of the specification of the patent application as filed as meaning: (1) that the application program has not been developed a priori with integration of the audio or video program in mind; (2) that the application program does not operate with knowledge that the audio or video program has been integrated therewith; and/or, (3) that the application program may be generally aware that other programs may be added thereon, but is specifically unaware that the audio or video program has been integrated therewith.

Applicant submits that Ouhyoung does not anticipate claim 1 as has been amended, in that Ouhyoung's application program, the E-mail system, is specifically aware that the audio or video program has been integrated therewith. This is made abundantly clear within Ouhyoung. The multimedia E-mail system in Ouhyoung is described as having "various media editors such as audio/video editors, image editor, sound editor, and six different types of text editors . . . ." (P. 315, sec. 1) The purpose of the multimedia E-mail system "is to provide an integrated

environment for multimedia document authoring, sending, receiving, and displaying." (P. 315, sec. 2) A goal of the multimedia E-mail system is to have "not only a multimedia file composer merely with basic functions . . . , but also a powerful media editor which provides a user with some special effect functions to edit." (p. 316, sec. 2) Finally, the multimedia E-mail system is "divided into five subsystems," including an "Authoring/Viewing module" and a "Media editor module." (P. 319, sec. 3.4)

Therefore, Ouhyoung's application program, the E-mail system, is specifically aware that the audio or video program, such as the Media editor module, has been integrated therewith. The purpose of the E-mail system is to have such an integrated environment, such that the application program in Ouhyoung is aware that the audio or video program has been integrated therewith. The goal of the E-mail system in Ouhyoung is to have a media editor integrated therewith, such that the application program is aware that the audio or video program has been integrated therewith. The multimedia E-Mail system has a Media editor sub-system designed therein *a priori*, such that the application program in Ouhyoung is aware that the audio or video program has been integrated therewith. In short, Ouhyoung's application program is aware that the audio or video program has been integrated therewith, and the integration is in fact the primary reason the application program was developed.

However, the invention of claim 1, as amended, is specifically limited to the application program being *unaware* that the audio or video program has been integrated therewith. Therefore, Ouhyoung does not anticipate amended claim 1, and claim 1, as amended, is patentable over Ouhyoung. Furthermore, it would not be obvious to modify Ouhyoung so that its application program is unaware that the audio or video program has been integrated therewith. This is because the *purpose* of the E-mail system is to have an *integrated* environment, and the *goal* of the E-mail system is to have a media editor *integrated* therewith. Therefore, modifying Ouhyoung so that its application program is unaware that the audio or video program has been

integrated therewith would very much destroy the explicitly stated intended purpose of Ouhyoung, such that Ouhyoung is not properly modified to yield the invention of claim 1.

Claims 3 and 4

Claims 3 and 4 have been rejected under 35 USC 102 as being anticipated by Ouhyoung. Claims 3 and 4 are dependent claims, depending from claim 2, and thus ultimately depending from claim 1. Claim 3 is directed to integration of the audio or video program by "*subclassing* into a window of the application program," whereas claim 4 is directed to such integration by "*hooking* into a window of the application program." The Examiner has indicated that Ouhyoung teaches or discloses such subclassing and hooking in FIG. 1 of Ouhyoung. However, FIG. 1 shows a "typical session of the MOS E-mail system," and does not anticipate the specific subclassing and hooking as to which claims 3 and 4 are limited.

Hooking and subclassing are generally described in the patent application as filed in paragraphs [0035]-[0041]. Applicant encourages the Examiner to reference these paragraphs in guiding his interpretation of what is meant by hooking and subclassing, inasmuch as hooking and subclassing are to be interpreted in light of the specification of the present patent application. However, Applicant recites portions of paragraph [0035] to advance the present discussion as to why Ouhyoung does not anticipate claims 3 and 4:

> Hooking and subclassing operate on messages within the messaging system of an OS. *Subclassing specifically deals with intercepting messages bound for one or more windows, which are intercepted before they can reach their destination window.* The intercepted messages can be processed, and then sent to its initial destination. Similarly, *hooking deals with intercepting messages, but at a broader scope than subclassing. Hooking allows the interception of messages at various points within the OS*, such that a message can, for instance, be intercepted *before or after* a window has processed the message.

(Emphasis added)

In light of these definitions of subclassing and hooking, FIG. 1 of Ouhyoung clearly does not teach or disclose subclassing or hooking to integrate an audio or video program within an application program. FIG. 1 provides no guidance as to intercepting messages bound for one or more windows, before they can reach their destination window, as to which subclassing means. FIG. 1 also provides no guidance as to intercepting messages at various points within the OS, before or after windows have processed the messages, as to which hooking means. In fact, FIG. 1 merely shows a general process flow of a multimedia email from a sending site to a receiving site. Inasmuch as hooking or subclassing intrinsically operates at either the sending site or the receiving site, and since FIG. 1 does not show either the sending site or the receiving site in detail, but merely represents each of these sites as a simple desktop computer icon, FIG. 1 of Ouhyoung does not teach or disclose subclassing or hooking. Therefore, Ouhyoung does not anticipate claim 3 or 4, such that claims 3 and 4 are independently patentable over Ouhyoung, irrespective of the patentability of their base claim 1 from which they depend.

Claim 7

Claim 7 has been rejected under 35 USC 102 as being anticipated by Ouhyoung. Claim 7 is a dependent claim, depending from claim 1. Claim 7 is directed to the audio or video program "modif[ying] contents of a window of the application program created through the operating system." The Examiner has indicated that Ouhyoung teaches or discloses such modification of the contents of a window of the application program by the audio or video program, specifically in FIGs. 7-9 of Ouhyoung. Applicant submits that FIGs. 7-9 of Ouhyoung do not disclose the audio or video program modifying contents of a window of the application program, such that Ouhyoung does not anticipate the claim 7.

FIGs. 7-9 of Ouhyoung disclose various windows of the "A/V editor," the "Sound editor," and the "Image/Graphics Editor." Such windows are thus of the various media editors within Ouhyoung themselves and do not depict – and are not described as depicting – modification of

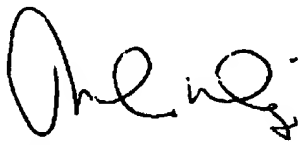
windows of the application program of Ouhyoung, the E-Mail system itself. Ouhyoung in fact does not provide any description of these windows. Ouhyoung thus does not teach or disclose modifying the window of the application program by the audio or video program. Indeed, FIGs. 7-9 more appropriately possibly read on claim 8, in which the audio or video program "runs in a window . . . related to a window of the application program." FIGs. 7-9 clearly do not, however, teach or disclose *modifying* the application program's window by the audio or video program, as to which claim 7 is limited.

Furthermore, Ouhyoung indicates that there is included within its system a "Media editor module," which is described as a "media editor [being] needed for creating and editing the media. . . . The media tools in MOS E-mail include editors for sound, audio/video, image, and text." (P. 319, sec. 3.4) It makes sense, therefore, that FIGs. 7-9 disclose the *windows of those audio and video programs themselves*, and *not the modification of the window of the application program by such audio and video programs*. There is no thus disclosure or teaching within Ouhyoung of the *contents of a window* of the MOS E-Mail program being *modified* by the media editors in Ouhyoung. Therefore, Ouhyoung does not anticipate claim 7, and claim 7 is patentable over Ouhyoung irrespective of the patentability of claim 1.

Conclusion

Applicant has made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Michael Dryja, Applicant's Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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